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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,123	11/26/2001	Andrew G. Swales	SAA-5-2	6275

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT PAPER NUMBER

2143

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,123

Applicant(s)

SWALES ET AL.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Examiner notes that Claim 11 has been amended and no Claims have been added or cancelled. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 6 December 2004 as reiterated herein below.

Terminal Disclaimer

1. The terminal disclaimer filed on 29 March 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 6,282,454 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Newly Amended Claim 11 and remaining Claims 12-21, 24-29 & 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent 5,862,391 to Salas in view of US Patent 5,375,070 to Hershey.

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4. Regarding Claims 11-14, 24 and 25, Salas discloses a network communication system, (Abstract; Col. 57, lines 30-67; Cols. 58-62), comprising:

- a master device for exclusively initiating a request message, (Col. 2, lines 3-12);
- a slave device being exclusively responsive, (providing a response message), to the request message header, (per pending Claim 13), exclusively initiated by the master device, (per pending Claim 14), (Col. 2, lines 3-32; Col. 6, lines 21-36; Cols. 23, 24; and Col. 26, lines 36-65), (Examiner notes that Salas discloses a configuration functionality wherein it would have been obvious to configure exclusive relationships between network components providing notification for the same as needed. Specifically, Examiner notes that a slave device obviously requires knowledge of its master device, which knowledge would be included within communication parameters set up during configuration.); and
- an optimal communication stack protocol utilized to communicate the request message and the response message between the master and the slave devices, (Col. 6, lines 5-45), the optimal protocol comprising:
 - an IP protocol, (Abstract; Fig. 3; and Col. 2, lines 26-32);
 - a TCP protocol, (Abstract; Fig. 3; and Col. 2, lines 26-32);
 - and

an application layer MODBUS protocol, (per pending Claims 12 & 25), wherein the building and parsing of the response message is responsive to a first part, or predetermined index of the request message, (Abstract; Fig. 3; Col. 2, lines 26-32; and Col. 26, lines 36-65).

5. As noted herein above, Salas discloses optimizing a MODBUS/TCP/IP stack, (Col. 6, lines 5-45), however, Salas does not specifically disclose or describe optimizing a MODBUS/TCP/IP stack with a "finite state machine" that takes advantage of a priori assumptions, (per pending Claim 24). Hershey discloses the use of finite state machines for performance optimization, (Col. 18, lines 37-48). The motivation to substitute the optimized MODBUS/TCP/IP stack of Salas with the finite state machine of Hershey is to provide an architecture and method for applying a real time feedback control to the logical or physical network behavior of a complex data communications network, (Hershey, Col. 3, lines 48-51). Thus, Claims 11-21, 24-29 & 31 are found to be unpatentable over the combined teachings of Salas in view of Hershey.

6. Regarding Claims 15, 27 and 28, Salas in view of Hershey is relied upon for those teachings disclosed herein. Salas further discloses a network communication system comprising a set of predetermined response messages including at least one predetermined response message, each predetermined response message being distinguishable by the first part of the request message wherein the predetermined response message is determined from the content of the first part of the request message and rapidly selected from the optimal

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communication stack for quickly responding to the request message, (Salas - Col. 6, lines 5-36). Examiner notes that protocols such as MODBUS, TCP/IP and Commnet obviously if not inherently comprise predetermined response messages. Thus, Claims 15, 27 and 28 are found to be unpatentable over the combined teachings of Salas in view of Hershey.

7. Regarding Claims 16-20, Salas in view of Hershey is relied upon for those teachings disclosed herein. Salas further discloses protocols such as MODBUS, TCP/IP, Ethernet and Commnet, which obviously if not inherently comprise predetermined response messages including, an address resolution protocol request message, an Internet control management protocol request message, a TCP connection request message, a TCP disconnect request message or a MODBUS request message as a TCP data frame, (Salas - Col. 6, lines 5-45 and Col. 29, lines 28-43). Thus, Claims 16-20 are found to be unpatentable over the combined teachings of Salas in view of Hershey.

8. Regarding Claims 21, 26 and 29, Salas in view of Hershey is relied upon for those teachings disclosed herein. Salas further discloses a network communication system wherein each device limits its message to a length that is less than both a TCP transaction length and a maximum transmission unit, (Col. 2, lines 20-32 and Col. 6, lines 5-36). Examiner notes that since Salas uses TCP/IP, the limitation of message length would be obviously if not inherently compatible with the TCP/IP protocol. Thus, Claims 21, 26 and 29 are found to be unpatentable over the combined teachings of Salas in view of Hershey.

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9. Regarding Claim 31, Salas in view of Hershey is relied upon for those teachings disclosed herein. Salas further discloses an Ethernet module wherein the control processing unit is operably coupled to a factory automation unit, (Fig. 2; Fig. 3; Col. 10, lines 15-67; and Col. 11, lines 1-18). Thus, Claim 31 is found to be unpatentable over the combined teachings of Salas in view of Hershey.

10. Claims 22, 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,862,391 to Salas in view of US Patent 5,375,070 to Hershey in further view of US Patent 5,757,924 to Friedman.

11. Salas in view of Hershey is relied upon for those teachings disclosed herein. Salas discloses the use of TCP protocol; however, Salas does not exclusively utilize TCP port number 502, (pending Claims 22 and 30), wherein any message not transmitted via the TCP port number 502 is ignored, (pending Claim 23). Friedman discloses a network device wherein a firewall/router decided whether to pass a packet based on the source and/or destination IP address and the TCP port number, (Friedman - Col. 3, lines 62-67 and Col. 4, line 1).

12. To incorporate the filtering method of Friedman into the Salas apparatus would have been obvious to one of ordinary skill in the art at the time of invention by Applicant as indicated within the teachings of Salas. The motivation to combine is found within the Salas teachings pertaining to a port byte, indicative of which port a gateway message is to be transmitted on, (Salas - Col. 6, lines 26-28). As Salas provides a method for distinguishing transmission by port number, the enumeration of a specific port number, (like 502), would have been obvious, particularly in light of the use of a MODBUS protocol, (as taught by

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Salas), which obviously utilizes port 502. Thus, Claims 22, 23 and 30 are found to be unpatentable over the combined teachings of Salas in view of Hershey in further view of Friedman.

Response to Arguments

13. Applicant's arguments filed 7 March 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how reconsideration avoids such references or objections.

14. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner notes that the combined references clearly and obviously teach all the elements and claim limitation of Applicant's invention rendering the same unpatentable.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner notes that proper motivation has been clearly enumerated herein above. Additionally, Examiner notes that the protocol disclosed within Salas clearly comprises the elements enumerated by Applicant defining an "optimal" protocol.

16. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again Examiner notes that proper motivation has been enumerated herein above.

17. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amendments and reconsideration of the same avoids such references or objections, Examiner hereby rejects all claims in their entirety as noted herein above.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

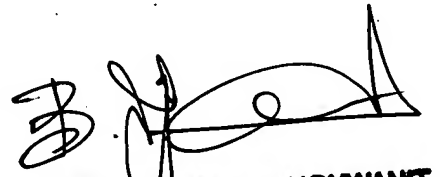
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
Art Unit 2143

AML



BUN JOE ARONCHOWITZ
PRIMARY EXAMINER